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In The  
**UNITED STATES CIRCUIT COURT OF APPEALS**

For the Ninth Circuit — Number 9693

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THE L. McBRINE COMPANY, LIMITED,  
Appellant,

vs.

SOL SILVERMAN and SAM SILVER-  
MAN, co-partners doing business under the  
name and style of BALKAN TRUNK &  
SUITCASE CO.,

Appellees.

- - - - -

THE L. McBRINE COMPANY, LIMITED,  
Appellant,

vs.

HERMAN KOCH, doing business under the  
name and style of H. KOCH & SONS, and  
HAROLD M. KOCH, WILLIAM L. KOCH,  
and REBECCA KOCH,

Appellees.

Consolidated

**FILED**

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PAUL P. O'BRIEN,  
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**REPLY BRIEF FOR APPELLANT**

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Upon Appeals from the District Court of the United States  
for the Northern District of California — Southern Division.

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**REPLY BRIEF FOR APPELLANT**

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**Introduction.**

Findings and Conclusions on the contested issues except with reference to the Koch defense were favorable to plaintiff-appellant; so in preparing our main brief we could not foretell whether or not the defendants would urge for consideration any of the additional defenses rejected by the District Court.

This reply brief will be confined to a consideration of matters concerned with the following defenses: The Koch defense; the Storch patents; and alleged non-infringement based on interpretation of the Shoemaker patent claims and the file wrapper.

### **The Koch Defense.**

We respectfully urge that this Honorable Court, even if it agrees that the District Judge was correct in giving credence to the testimony of the witnesses for the defense and in accepting the supporting exhibits, can set aside the Conclusion of Law concerning the Koch defense and the corresponding Finding of Fact (Conclusion of Law 1 and Finding of Fact 7) *for the reason that there was an obvious misapplication of the proven facts to the law.* The law is exceedingly strict in its requirements as to the class and character of testimony and exhibits which are sufficient to establish a prior use for the purpose of invalidating a patent. The proofs adduced on behalf of the defendants in connection with the Koch defense do not measure up to these requirements. Not one of the five thousand or more Koch luggage cases alleged to have been manufactured and sold was produced and offered in evidence.

Under Rule 52 of the Federal Rules of Civil Procedure in actions tried by the Court without a jury "the question of the sufficiency of the evidence to support the findings may thereafter be raised \* \* \*."

In summarizing our views on this subject we wish to emphasize that:

1. The claims of the Shoemaker patent in suit define a piece of hand luggage having garment folding fixtures mounted therein in an advantageous specified relationship to produce a new and useful result.

2. In 1928, and prior thereto, fixtures used in wardrobe hand luggage in packing and operating arrangements were arranged and disposed decidedly different from that of the Shoemaker invention, and that the fixtures obtained by the Kochs in 1928 were susceptible of being mounted in luggage in many different ways (of which that depicted in the cut opposite p. 44 of our main brief is one example) remote from the Shoemaker concept.

3. The defendants are relying only on oral testimony of interested parties as to events twelve years back in their attempt to prove the existence, use, and sale of hand luggage like defendants' Exhibits K, L and S.

4. If five thousand or more cases like Exhibits K, L and S had in fact been sold, the defendants, with little effort, could have located and offered in evidence contemporaneous physical or documentary exhibits which would show *without doubt* how the fixtures were in fact arranged in the early luggage cases. Their failure so to do, or an adequate explanation, puts them squarely under the "best evidence" rule, and raises a presumption that actual contemporaneous showings of the early luggage cases would have been unfavorable to their contentions.

5. In view of the foregoing, the District Court did not make a correct application of the proven facts to the law, and this Honorable Court should reverse the lower court holding with respect to the Koch defense and decree that the Shoemaker patent is good and valid in law.

As to cases with fixtures arranged therein like defendants' Exhibits K, L and S (*prepared for the purposes of this litigation just prior to the trial*) we only have the word of Mr. Maurice Koch, son of one of the defendants and interested in H. Koch & Sons, together with certain vague statements of Frank Kapps and Thomas Merryfield. Mr. Kapps was questioned as to whether or not he ever saw a case or box having fixtures therein assembled

in the manner shown in defendants' Exhibit K and he replied (R. p. 313):

“Yes, we put it in a *temporary* assembly.” (Italics ours.)

On cross examination he admitted that he was trying to recollect something that occurred fifteen years ago, and in addition Mr. Merryfield's testimony was very general.

We respectfully submit that the memory of these two witnesses was prodded by a confrontation with an exhibit, *recently made for the purpose of this litigation*, having fixtures therein assembled in a certain desired relationship. It would be an easy matter, considering that many years had elapsed and that they had undoubtedly seen and worked on numerous fixtures since 1928, for them to honestly but mistakenly believe at this date that the original fixtures were assembled in the manner shown in the newly made exhibits, whereas, it is logical, considering the vogue in fixture arrangements prevailing in 1928, that the original fixtures might have been, and we contend were, mounted in a suitcase in an entirely different relationship.

The Koch defense must fail unless it is established, by that degree of proof required by the law, that the fixtures were assembled in suitcases in a very definite relationship as called for by the relied upon claims in the Shoemaker patent. The defendants seek to prove this assumption merely on the basis of *oral* testimony of interested parties relating to something which occurred twelve years previous. The contemporaneous physical exhibits and documentary evidence in this case only establish at best that Larkin Specialty Co. manufactured for H. Koch & Sons certain types of frames, garment bars and sockets. The proofs do not establish the existence, use and sale of suitcases having the fixtures mounted in the hinged side of the cover of a wardrobe luggage case in a manner so as to satisfy the terms of the Shoemaker claims.



*There is not one iota of record evidence or anything in the way of contemporaneous physical exhibits to substantiate the use and sale in 1928 or thereafter of suit-cases similar to defendants' Exhibits K, L and S. We only have the oral testimony of Maurice Koeh that this was a fact, coupled with the oral testimony of Albert Kantrow, who operated luggage stores in San Francisco and jobbed Koch products. Although Mr. Kantrow alleged that he bought from the Kochs and subsequently sold, during a period of several years, at least a hundred or more of the cases in question per month, not a single piece of record evidence with respect to the assembled cases was produced to verify this bare statement.*

We think that this Honorable Court may well take judicial notice of the fact that hand luggage is extensively advertised both by manufacturers and retailers. If numerous luggage cases like defendants' Exhibits K, L and S were in fact sold to the public and put into extensive use in 1928 and thereafter, *how can the defendants account for the fact that they have failed to produce as physical or documentary exhibits any of the following material which should be available or procurable:*

1. An actual case manufactured and sold in 1928 or thereabouts (some cases certainly must have been in the possession of members of the family or relatives of either Mr. Kantrow or the Kochs, or purchasers in the immediate vicinity), or

2. A contemporaneous photograph of the luggage case, or

3. A contemporaneous newspaper advertisement and cut thereof, or

4. A contemporaneous catalog or advertising folder showing thereof; or

5. Invoices or sales records of contemporaneous date of Mr. Kantrow's company showing legitimate transactions in regard to luggage cases of the type under consideration.

Some of the above items should have been readily procurable by these defendants for use at the trial and introduction into evidence if suitcases like Exhibits K, L and S had in fact existed in 1928, and had been manufactured and sold in numbers in the thousands, and had gone into extensive usage. All of the transactions were on the West Coast and in the immediate vicinity of San Francisco. It was a *duty* of the defendants to produce tangible record evidence or physical exhibits to substantiate their claims with regard to the Koch defense that the fixtures were assembled in suitcases in the required manner, if such a defense is to be accepted. The defendants did not produce any material of the nature above suggested nor did they explain their failure to do so. Instead, they relied merely on oral statements of interested parties. This situation is exactly parallel to that in the case of *H. Mueller Mfg. Co. vs. Glauber*, 184 Fed. 609 (C. C. A. 7). In the reported case the defendants sought to establish a so-called prior use by an exhibit which was not one of the original pipes but was a facsimile thereof (just as in the instant case). The Court on page 618, in commenting on the testimony of the witnesses, stated:

“Their testimony so far as it goes is emphatic. But it suggests a lack of endeavor to procure the best evidence.”

The Court then goes on to reiterate the well-known rule that in the case of oral testimony the existence of the alleged early devices must be proven by evidence which is clear, satisfactory, and *beyond a reasonable doubt*. A further statement by the Court on page 618 warrants reproduction here:

“What has become of the great number of these pipes which they say were manufactured? Were they used at all, and, if so, where? It is not at all probable in the ordinary course of things that they have all disappeared. No attempt is made on the

part of appellant to show that they were in actual use, or had been placed in the hands of the public. No original coupling-pipe made by the Nelson Manufacturing Company at the time of the alleged prior use is produced. The witnesses are shown an alleged duplicate of the original pipe and depose from memory alone that it is the same device. However clearly and emphatically the testimony of such witnesses may be given, yet if it may reasonably be deduced from all the record that other and conclusive evidence might have been obtained, the existence of which is not negatived, nor its absence accounted for, the court is forced to the conclusion that it is purposely withheld. There is no excuse for the failure to follow up the coupling-pipes alleged to have been made by the Nelson Manufacturing Company.

“It is conceded that prior use must be established beyond a reasonable doubt. There must always be doubt in the mind of the court, when no effort is made to produce in evidence facts, the existence of which may reasonably be inferred from the record in the absence of any excuse for the omission. In such case the prior use cannot be said to be established beyond a reasonable doubt. We therefore conclude that the prior use contended for, as shown in this Nelson pipe, is not made out with the certainty required in such case.”

This language so aptly fits the instant situation that it might well be paraphrased to correspond with the Koch situation. In other words, in using the language of the Court, the inquiry should be raised: What has become of the great number of these wardrobe luggage cases which they (the Kochs and their witnesses) say were manufactured? It is not at all probable in the ordinary course of things that they have all disappeared. No original luggage cases made by Koch at the time of the alleged prior use were produced. The witnesses (Kantrow, Kapps and Merryfield) are shown an alleged duplicate of the original luggage case and depose from memory alone that it is the

same device. "However clearly and emphatically the testimony of such witnesses may be given, yet if it may reasonably be deduced from all the record that other and conclusive evidence might have been obtained, *the existence of which is not negatived, nor its absence accounted for*, the court is forced to the conclusion that it is purposefully withheld." (Emphasis ours.)

Before passing to the next topic we wish to point out the fact that the alleged Koch development does not in fact meet the requirements of the relied upon claims Nos. 4, 8, 10, 11, 12, 19, 23, 24 and 26 of the Shoemaker patent in suit. All of these claims require that the garment supporting means (a hanger or garment draping bar) be removably carried by the hinged or inner end or side of the garment supporting member (the swing frame). In other words, it is one of Mr. Shoemaker's important contributions to the art that the removable garment bar be removably *mounted directly on the inner or hinged end of the swing frame*. The advantages of this arrangement are completely dealt with in our main brief and were brought out by the testimony of plaintiff's witnesses, including Messrs. A. A. Ritter and Irving Roemer. The difficulties and disadvantages in a structure wherein the individual garment bar or hanger is mounted independently of or free of the swing frame were clearly demonstrated in the trial below when it appeared from Mr. Koch's demonstration that so much strain was placed on the individual garment bar in one of the exhibits that it jumped out of its sockets when the frame was swung to packing position, and that furthermore objectionable elongation took place causing injurious distortion to or stretching of the garments.

The appellees direct attention to the showing in Fig. 9 of the Shoemaker patent wherein the hanger rod is mounted in sockets independent of the swing frame. This is merely a modification. Furthermore, the showing in

Fig. 9 of the Shoemaker patent is not covered by relied upon claims Nos. 4, 8, 10, 11, 12, 19, 23, 24 and 26.

### The Storch Patents.

Plaintiff-appellant has repeatedly urged that the Storch United States patent (R. Vol. II, p. 661) on which defendants strenuously rely as a defense, *is not a part of the prior art*. This patent was filed after the application for the Shoemaker patent in suit. Defendants contend that Storch is entitled to an effective filing date in the United States (and hence a constructive reduction to practice) as of September 1, 1928, the date on which Storch filed an application in Austria.

The defendants' contentions in this respect are based on the International Convention Treaty and Section 4887 of the Revised Statutes. We have no quarrel with the defendants concerning Section 4887, but the effect of Section 4887 does not make the Storch United States patent prior art as against Shoemaker, an earlier filer in the United States. We direct attention to Section 4923 of the Revised Statutes (U. S. C. Title 35, Section 72). This section of the Statutes is directly controlling because, prior to the Shoemaker invention, the Storch development "had not been patented or described in a printed publication."

Section 4923 follows Section 4887 and was advisedly enacted to cover certain situations concerning possible origin of an invention by another party in a country foreign to the United States. The rights provided by Section 4887 are priority rights which affect or extend only to the foreign inventor when he files in the United States. These rights do not extend to third parties nor permit them to give to a desired United States patent a fictitious United States filing date for the purpose of thus manufacturing prior art to shield the said *third party* from responsibility for infringement of another's duly issued patent.

In a long line of decisions the Courts, ending with the Supreme Court of the United States, have recognized that Section 4923 applies to situations like the one at bar. Attention is respectfully directed to the decisions noted and discussed in our main brief commencing on page 59. These cases all refer to and discuss the application of Section 4923 and verify plaintiff's contention that the Storch United States patent can not be converted into prior art because of Storch's activities in Austria and his filing of an application in Austria at an earlier date. *The Storch Austrian patent did not issue, and hence did not become a publication until long after Shoemaker's filing date in the United States.*

The defendants refuse to discuss the established cases dealing with Section 4923. Instead, they attempt to befuddle the issues by referring to decisions dealing with Section 4887 and other questions. The cases cited by defendants simply are not here applicable and deal with situations and conditions different from those here involved.

To demonstrate counsel for defendants' confusion or lack of desire to apply the proper law in the present situation, let us look at certain remarks in appellees' brief. On page 45 for instance, they say:

“However, Section 4923, on its face, applies only to prior knowledge and use in a foreign country. It does not purport to deal with patent rights established under the Treaty, and which, under the decision in the Milbourn case, carry through to the issuance of a patent regardless of the date of issuance.”

Note that our opponents say that Section 4923 applies only to prior knowledge and use in a foreign country, and does not apply in regard to foreign situations where a patent was applied for.

We do not understand how counsel could have arrived at this conclusion from a review of adjudications dealing

with Section 4923, including the recent Supreme Court *Schimidzu* case. However, a recent decision is so clear and explicit in regard to a situation like that at bar, that our opponents cannot deny the force of our position and the applicability of Section 4923. Contrary to the statement in our opponents' brief quoted above, the new citation clearly demonstrates that a United States patent can not be invalidated on the basis of another United States patent, filed later in this country, but whose subject matter was the basis for an earlier filed application in a foreign country belonging to the International Convention.

The new case which we refer to was recently decided by the Second Circuit Court of Appeals and is reported in the Federal Reporter Advance Sheets of March 24, 1941, 117 Fed. (2d) 481. The case is entitled *Celanese Corporation of America vs. Ribbon Narrow Fabrics Co., Inc.*, decided February 10, 1941. The defendants in this case attempted to invalidate the Dreyfus United States patent No. 1,773,967 on the basis of a United States patent issued to Sponholz. The Dreyfus patent issued on an application filed October 5, 1927 and Dreyfus' inventive acts were carried back to September, 1926. Sponholz (patentee of the urged reference) filed in the United States November 23, 1926, but Sponholz had applied for a German patent on May 11, 1926. This was within one year of Sponholz' filing date in the United States and therefore, according to the present defendants' fictitious theory, Sponholz should have had an effective filing date in the United States to correspond with his filing date in Germany, or May 11, 1926, which was prior to Dreyfus' filing date in the United States of October 5, 1927. On the question involved we wish to quote the language of the Court as follows:

“The Court found that Dreyfus completed his invention some time in September, 1926 and there was no proof that Sponholz was entitled to a date

of invention earlier than his filing date. Sponholz had previously applied for a German patent on May 11, 1926 but that is immaterial as there is no proof of any German patent or published printed description of the same subject matter prior to Dreyfus.’’

This decision and the above quotation fully answers the present defendants’ contentions and disposes of the same most effectively.

The ridiculousness of the statements made on page 45 of appellees’ brief must be apparent. There, they say that Section 4923 applies *only to prior knowledge and use in a foreign country and does not purport to deal with patent rights established under the treaty*. If defendants have not heretofore been convinced as to the soundness of our contentions through the line of decisions previously cited, they can not question the language in the *Celanese* case which fully disposes of their fictitious theory of differentiation.

Appellees’ brief, on pages 42 to 46 inclusive lists and refers to a number of cases. A review of appellees’ citations will disclose that the situations in the cases are in no wise parallel to the instant situation. In the situations covered by appellees’ citations, the parties seeking to secure the benefits of the earlier filing dates (either foreign or domestic) were actually the applicants themselves or their assignees. These cases were simply concerned with priority contests. Not any of the citations in appellees’ brief cover situations wherein third party infringers sought to use United States patents and derive the benefit from earlier filing dates of the same in foreign countries for the purpose of attempting to invalidate the regularly issued United States patents which were being infringed by the third parties. In the instant situation the law as stated by Section 4923 of the Revised Statutes governs and this was stated to be the situation in the recent *Celanese* case



heretofore referred to. See also *Merrell-Soule Co. vs. Powdered Milk Co. of America*, 222 Fed. 911.

On page 43 of appellees' brief an attempt is made to liken Mr. Shoemaker to Whitford's position in the Supreme Court *Milburn vs. Davis-Bournonville* case. The difference is that Clifford and Whitford were involved in a priority contest. In the case at bar Shoemaker was a stranger to Storch. There was no contest as between Storch and Shoemaker and under Section 4923 and in accordance with all of the cases interpreting said section of the Statutes, third parties, such as the present appellees, can derive no benefit from Storch's filing in Austria.

Defendants should have noticed and given heed to the clear statement of the Court found in the *Milburn vs. Davis-Bournonville* case on which they rely. At the end of its opinion the Court says:

“The policy of the Statute as to foreign inventions obviously stands on its own footing and cannot be applied to domestic affairs.”

Likewise, defendants seem to have overlooked the very important expression by this Honorable Court in the case of *Craftint Manufacturing Company vs. Baker et al*, 94 Fed. (2d) 369 wherein it was stated:

“Until a foreign invention has been patented or described in a prior printed publication it cannot be used to negative novelty.”

Counsel for plaintiff-appellant are not attempting to “overrule the Supreme Court” as factitiously suggested by appellees on page 52 of their brief. We are merely attempting to point out that the *Milburn* case, and cases dealing with Section 4887 do not apply; but Section 4923 and the cases dealing therewith are the ruling law on the question here involved.

On pages 53 and 54 of their brief, counsel for appellees contend that under the *Westinghouse vs. General Electric* case, Section 4923 was found applicable for the reason “*merely* the invention had been known or used in a foreign country.” They seemed to think that if, in the *Westinghouse* case, the user had filed an application in a foreign country and had followed with an application in the United States within twelve months, the situation would be changed. This was precisely what happened in the *Celanese* case we have previously referred to and in which the court stated that the prior activities in the foreign country, *including the filing of a patent application in the foreign country* were of no avail as against the United States patent in question because there had been *no issued patent or printed publication in the foreign country.*

### **The Storch Disclosures Are Not Anticipatory of the Relied Upon Claims of the Shoemaker Patent in Suit.**

This subject was discussed in our main brief commencing on page 64. The District Court was not impressed with this defense and an inspection of the several Storch patents will show that it would take a great stretch of imagination to contend that their showings suggest the simple and effective wardrobe luggage invention of the Shoemaker patent. We have complained over the admission in evidence of defendants’ Exhibit U (R. Vol. II, p. 690). The showing therein in the left hand upper corner is not in any way justified by the showing in the Storch patent. Counsel for defendants, who prepared this drawing, drew on their imagination and indulged in wishful thinking. In our main brief we have pointed out why this showing does violence to the disclosure in the Storch patent. Appellees apparently have recognized the justice of our complaint because on page 55 of their brief they have now made a new showing of the Storch patent. It should be noted that the stop

17 precludes the arm A-1 from swinging horizontally onto the bottom section of the case. Also the arms 3 extend to a height greatly above the free end of the open cover of the suitcase. How could this frame arrangement be swung in a counterclockwise direction? It would strike the top of the open cover and be rendered inoperative. We submit that the more one studies the showing of the Storch patent the more one wonders how the device was intended to operate and how it can in fact operate and fold and compact garments.

### **Re File Wrapper of Shoemaker Patent and Infringement of Claims in Suit.**

The defendants contend that the relied upon claims of the Shoemaker patent in suit should be read in such a limited manner as to require the hinged connection of the garment supporting member or frame to be on a specific rear panel of the cover of the luggage.

In some of the original claims submitted in the Shoemaker application the garment supporting member or frame was defined as being "hingedly connected relative to the hinged side of the cover." In Paper No. 2 in the file wrapper (R. Vol. II, p. 486), the action from the Patent Office dated July 29, 1929, the Examiner cited the following patents: *Boyd et al No. 1,185,971 and Burchess No. 1,081,014*. In regard to certain of the claims the Examiner stated:

" 'Relative' is ambiguous and should be cancelled."

This simply meant that in the Examiner's opinion the word "relative" was too general and vague. Of the references cited, the Boyd et al patent was the only citation of any significance in the connection of a frame arrangement with a piece of luggage. By referring to the Boyd

et al patent (R. Vol. II, p. 553) it will be noted that this is a wardrobe trunk structure having a pair of foldable trolleys each hingedly connected at the upper end of the wardrobe section of the trunk. In this arrangement the trolleys might casually respond to the claimed garment supporting member of Shoemaker and the attorneys merely sought to overcome the Examiner's objection as to the word "relative," in connection with this reference by changing the claims so as to bring out that applicant's garment supporting member or frame was hingedly connected *at its opposite ends*. This change in phraseology was for the purpose of pointing out that the applicant's frame member was a unitary device having opposite ends at its inner portion and these opposite ends were hingedly mounted within the luggage as distinguished from the trolleys of Boyd et al which were two in number and therefore not of a nature to be *connected* at its opposite ends. In the following amendment the attorneys therefore changed the claims in this respect merely for the purpose of overcoming the ambiguity of the word "relative" and differentiating the connection of the Shoemaker frame from the several connections of the trolleys in the Boyd et al patent.

File wrapper estoppel would only apply if the following had been true: If the prior art had disclosed the combination of a garment supporting frame carrying, in loaded position, a hanger at its inner end, with the inner ends of the frame being mounted at the lower ends of the side walls of the cover, then, probably Shoemaker would be justifiably limited to claims which would only cover a structure wherein a frame was mounted on the specific rear or inner hinged panel of the cover. This was not the case, however. Shoemaker is very definitely entitled to a construction of his claims which will include in a luggage case a hinged frame, carrying a detachable garment bar, with the frame mounted within the zone of the inner or hinged end portion

of the cover. This is what is disclosed in the Shoemaker patent and this is what the defendants do, and *this association of parts is not disclosed in any of the prior art.*

We have demonstrated in our main brief, page 22 et seq., and by means of the cuts shown opposite page 26, that the defendants, just as much as Shoemaker, do in fact actually mount their frames on the hinged side of the cover. We do wish to insist, however, that the file wrapper of the Shoemaker patent does not spell the situation urged by the defendants, creates no estoppel whatsoever, and is of no consequence in this proceeding.

This Court very recently, in *Research Products Co., Ltd. vs. The Tretolite Company*, 43 U. S. P. Q. 99 on page 104, spoke on the subject of so-called "file wrapper estoppel." In effect this Court acknowledged that claims should be given their logical and intended meanings and interpretations notwithstanding withdrawal of certain claims during the prosecution of the application.

The correct rule on this subject is also very accurately expressed in *United States vs. Mitchell*, 74 Fed. (2d) 569 wherein the Court said on page 571:

"Distinctions are made and limitations are sometimes placed on language of claims by applicant's counsel which are somewhat inaccurate or made to meet a precise prior art citation, and without much thought as to their effect on other structures designed to avoid infringement. We should therefore be careful and avoid such construction of the claims as will defeat the real discovery which the inventor is contributing to the art."

The interference proceeding between the Shoemaker application and an application of the party Wheary had no relationship whatsoever to the structure for effecting compound folding of garments, defined by the claims of the Shoemaker patent here in suit. Wheary had invented a

structure which consisted merely of a U-frame with long side arms, and the contest was only with relation to extremely broad claims covering generally a U-frame having its inner end pivotally mounted relative to the hinged section of the cover of a wardrobe case. The Wheary structure did not have a removable bar associated with the inner end of the frame for effecting compound folding of garments.

The claims which Shoemaker conceded to Wheary in the interference proceeding had no limitations therein with respect to the removable garment bars at the inner end of the frame. The Wheary invention, and the claims in connection therewith, related only to the U-frame of the Winship type, with longer side arms. The attorneys for Mr. Shoemaker made the amendment, eliminating the word "relative" immediately after the first action from the Examiner appearing on page 488 of Vol. II of the Record and *before* the interference contest with Wheary and before a final rejection of any of the claims presented.

The appellees attempt to make much of the recent Supreme Court case of *Schriber-Schroth Co. vs. Cleveland Trust Co. et al*, 61 Sup. Ct. Rep. 234, 47 U. S. P. Q. 354. May we say briefly that the facts in the instant case are not parallel to the facts in the *Schriber-Schroth* case, and the law announced therein is not applicable nor controlling in the instant situation.

The Supreme Court case involved the following important factors:

1. The patent owners attempted to read into the claims *an element which was entirely and totally lacking therefrom.*

2. The claims were invalid because of the prior art without said element.

3. The *essential* element was *not mentioned* in the claims.

4. The essential element was surrendered to an opponent during an interference.

In the case at bar, during the prosecution of the Shoemaker application, the early amendments referred to were only with respect to the word "relative" with relation to the connection of the frame with the hinged side or zone of the cover. The applicant (Shoemaker) never surrendered the element of a frame hingedly carried by the hinged side or zone of the cover. Therefore, there is not an attempt to read into the claims in suit an element which is totally lacking from the claims.

The validity of Shoemaker's claims is not affected by which interpretation is given thereto. They are valid if "the hinged side of the cover" is properly interpreted to mean "that zone of the cover, from the horizontal center line downwardly, which is hingedly connected with the body of the case," or if defendants' unjustified narrow interpretation is followed.

Shoemaker's claims are not and never were devoid of an essential element. The claims in suit do define a hinged connection of the frame or garment supporting member with a proper portion of the cover.

No essential element of the claims in suit was surrendered to Wheary during the interference. Shoemaker simply limited his invention to a certain form of frame *and cooperating bar or hanger*, with the frame connected to a portion of the *cover*. Wheary obtained priority on the broader idea of a mere U-frame (devoid of cooperating bars or hangers) pivotally mounted in the region of the connection between the cover and body sections of the case. As a matter of fact Wheary disclosed connections between the frame and the *body* of the case as distinguished from Shoemaker's connections between the frame and *cover* of the case.

The foregoing will simply demonstrate that the facts in the instant case are not parallel to those in the *Schriber-Schroth* Supreme Court case and the holding in said case is not applicable to the present situation.

As demonstrated by the cuts appearing opposite page 26 of our main brief, it must be clear that the accused structures of the defendants are within the terms of the claims of the Shoemaker patent without any distortion thereof, and that nothing in the file history of the Shoemaker patent can prevent said claims from being given their natural and intended meaning, which will embrace the accused structures.

Respectfully submitted,

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